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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/970,953 | 10/04/2001 | John Moetteli | 777-a | 2655 |
| <div>7590 08/09/2007</div> <div>John Moetteli Case Postale 486 Geneva 12, CH-1211 SWITZERLAND</div> <div>EXAMINER HALIM, SAHERA</div> <div>ART UNIT PAPER NUMBER</div> <div>2157</div> <div>MAIL DATE DELIVERY MODE</div> <div>08/09/2007 PAPER</div> | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/970,953

Applicant(s)

MOETTELI, JOHN

Examiner

Sahera Halim

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/12/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to an Amendment filed on May 17, 2007.
2. Claims 1-4 have been amended.
3. The amendment filed May 17, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "encoded in a computer program product (i.e., stored in CD form and operating through a processor and in memory on a PC".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 3-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner failed to find support in the specification for the limitation of "a computer

program product". It is unclear what the computer program product is in the specification.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 3-4 are directed to non-statutory subject matter. Claims 3 and 4 are claiming a program product encoded with a communication method, wherein the method causes the pc to perform certain steps, which is still a program. Claims 3-4 fail to fall into the statutory category of inventions.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,285,985 to Horstmann (hereinafter Horstmann).

10. Reference to claim 1, Horstmann teaches a banner management method wherein the method causes the display of computer oriented information in a banner window integrated into a browser users interface on terminals in a network of terminals, wherein the information displayed on the browser user interface is visible during browsing, the method comprising the steps of (abstract): (1) initializing a command file with inputs from a system administrator of the network (col. 4, line 27 – 46 and Fig. 4; Horsmann teaches the software developer inputting information though a prompt window), including providing banner window customization means by which information displayed in a banner window on each browser interface is customizable by the system administrator (See Fig. 4 and Fig. 6 and col. 3, line 49 – 61, col. 4, line 27 – 46; Horsmann teaches customizing information displayed in banner window of Fig. 6 through selecting user profile options) (2); and executing the command file, thus displaying banners as ordered by the command file (col. 2, line 58 – col. 3, line 24); and (2) executing the command file, thus displaying banners as ordered by the command file (col. 2, line 58 – col. 3, line 24).

11. Regarding claim 2 Horsmann teaches the banner management method of claim 1, wherein the information is a banner (see Fig. 6, ad screen).

12. Claims 3 and 4 have similar limitations as to claims 1 and 2; therefore they are rejected under the same rational.

Response to Arguments

Applicant's arguments filed May 17, 2007 have been fully considered but they are not persuasive.

The applicant argues on page 5 of the Remarks that a computer program product is essentially a computerized method encoded on a computer-readable medium, widely known as a computer program product. There are many exiting patents that contradict that a computer product has to include a computer readable medium.

13. The applicant argues in regards to 102 rejections that Horstmann fails to teach integrating the banner window into the browser GUI. First of all, the recitation "integrated into a browser interface" occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Second, the reference does teach this limitation. Referring to Fig. 6, without opening the browser first, the ad would not open. Therefore, the banner window is integrated into the browser user interface. Third, Horstmann's invention is not limited to Fig. 6 (see col. 3, lines 5 –61). The applicant further argues that Horstmann teaches an Advertiser-controlled system, while the present invention describes a company-oriented method. Horstmann's Advertiser-controlled system, as called by the applicant is also a company-oriented system. It is used by a company.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sahera Halim whose telephone number is (571) 272-4003. The examiner can normally be reached on Mondays and Thursdays from 8:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sahera Halim
Patent Examiner
AU : 2157

August 2, 2007



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